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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,588	08/21/2001	Dean P. Alderucci	01-023	6856
22927 7590 04/07/2009 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
RETTA, YEHDEGA				
ART UNIT		PAPER NUMBER		
3622				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/933,588

Applicant(s)

ALDERUCCI ET AL.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 4, 11-16 and 38-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 4, 11-16 and 38-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 1, 2, 5-10, 17-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 21, 2009.

Applicant argues that the Examiner has failed to establish a serious burden exists. Applicant asserts each of the claim groups has been given the exact same classification (705/14), accordingly contrary to what is asserted the examination of all the alleged groups would not necessitate a separate field of search. Examiner would like to point out that according to MPEP Where the * inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

- (A) Separate classification thereof : This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.
- (B) A separate status in the art when they are classifiable together : Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by

citing patents which are evidence of such separate status, and also of a separate field of search.

(C) *A different field of search* : Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes /subclasses or electronic resources, ***or employing different search queries***, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Group I which is a method claim includes a step of *determining, by a point-of-sale terminal*, an upsell in which the point-of-sale terminal *does not comprise a vending machine*;

Group II which is an apparatus includes a processor (embodied in a cash register) operative to receive purchase, determine an upsell and rounded price and provide an offer. In this case the search requires that a processor performs all the limitation cited above, which is different from the search of group I which required that the point of sale terminal which is not a vending machine to perform only the determining of upsell. There is no requirement for the rest of the steps to be performed by any device.

Group III which is a method claim requires that the point of sale receives a purchase which is not required by the point of sale of group I. Group III also requires that the upsell corresponds to an item such that the cost of the upsell does not exceed the difference between the purchase price and the rounded price which is not a requirement for Group V.

Group IV which is a method claim requires a step of selling at a point of sale terminal an item and upsell. The rest of the claimed steps are not tied any device. The search queries would be different from the search queries of Group I-III.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4, 11-16 and 38-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites determine a rounded price for at least one item and the upsell in which the determining the rounded price is irrespective of any amount tendered for the purchase. Since the claim recites that the processor (operative with a program) only receive a purchase of an item and is operative to determine a rounded price only based on the item, it is unclear how the processor consider or not consider what is tendered (or offered). In short there is no relationship between the processor and what is tendered for the purchase, therefore no patentable weight is given to the claimed language of "amount tendered for the purchase" since this specific information is not used by the processor.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3, 4, 11-16 and 38-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 6,397,193).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 3-4, 11-Walker teaches a processor operative with the program (see col. 7 line 57 to col. 8 line 14, col. 11 lines 48-65) to receive a purchase that includes at least one item (see col. 7 lines 41-56); determine an upsell based on the item by accessing a database (see col. 10 lines 29-65); determine a rounded price for the at least one item and the upsell; in which the determining the round price is irrespective (regardless) of any amount tendered (payment offered) for the purchase; and provide an offer to exchange the at least one item and the upsell for the rounded price (col. 10 line 66 to col. 11 line 8); receiving a response to the offer and exchanging it for the rounded price (see col. 11 lines 24-32).

Regarding claims 11-16, Walker teaches to receiving a purchase that includes at least one item (see col. 7 lines 41-56); determining a record and an upsell based on the record in a database (col. 7 lines 1-17, col. 10 lines 29-65); determining a rounded price based on the record for the at least one item and the upsell; in which the determining the round price is irrespective (regardless) of any amount tendered (payment offered) for the purchase; and selecting an upsell that correspond to the item and the cost of the upsell and offering the upsell; determining a purchase price and a rounding multiple based on the record and rounding the purchase price in accordance with the rounding multiple; adding the purchase price to the sell price, thereby generating the rounded price; a required payment amount to be rounded price (col. 10 line 66 to col. 11 line 34);

Claims 3-43 are rejected as stated above in claims 11-16.

Claims 3, 4, 11-16 and 38-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 6,119,099).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 3-4, Walker teaches a processor operative with the program to receive a purchase that includes at least one item; determine an upsell based on the item by accessing a database; determine a rounded price for the at least one item and the upsell; in which the determining the round price is irrespective (regardless) of any amount tendered (payment offered) for the purchase; and provide an offer to exchange the at least one item and the upsell for the rounded price; receiving a response to the offer and exchanging it for the rounded price (see fig. 2-4 and corresponding paragraphs).

Regarding claims 11-16, Walker teaches to receiving a purchase that includes at least one item; determining a record and an upsell based on the record in a database; determining a rounded price based on the record for the at least one item and the upsell; in which the determining the round price is irrespective (regardless) of any amount tendered (payment offered) for the purchase; and selecting an upsell that correspond to the item and the cost of the upsell and offering the upsell; determining a purchase price and a rounding multiple based on the record and rounding the purchase price in accordance with the rounding multiple; adding the purchase price to the sell price, thereby generating the rounded price; a required payment amount to be rounded price (see fig. 2-4 and corresponding paragraphs).

Claims 3-43 are rejected as stated above in claims 11-16.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR
/Yehdega Retta/
Primary Examiner, Art Unit 3622